

REMARKS

By this amendment, claims 1-31 are pending, in which claims 15-31 are newly presented. No new matter is introduced.

The final Office Action mailed August 11, 2008 rejected claims 1-14 under 35 U.S.C. § 112, first and second paragraphs, and claims 1-14 under 35 U.S.C. § 102(e) as anticipated by *Harris et al.* (US 6,813,477).

Applicants respectfully traverse the rejections of claims 1-14 for the reasons put forth below.

Regarding the rejection under the first paragraph of 35 U.S.C. § 112, the Final Office Action states that claims 1-14 fail to comply with the enablement requirement of 35 U.S.C. § 112, first paragraph. In particular, the Final Office Action contends that the claim feature, “the stress to which the mobile-telephone under test is subjected is influenced in a targeted manner the number of transmission blocks of a multi-block” in claims 1 and 9 is not enabled because the “specification fails to properly describe how a person of ordinary skill in the art can determine the amount of stress on the mobile-telephone device under test based on some targeted manner” (Final Office Action-page 3).

To comply with the enablement clause of the first paragraph of 35 U.S.C. 112, the disclosure must adequately describe the claimed invention so that the artisan could practice it without undue experimentation. *In Re Scarbrough*, 500 F.2d 560, 182 USPQ 298 (CCPA 1974); *In re Brandstadter*, 484 F.2d 1395, 179 USPQ 286 (CCPA 1973); *In re Gay*, 50 CCPA 725, 309 F.2d 769, 135 USPQ 311 (1962). If the examiner had a reasonable basis for questioning the sufficiency of the disclosure, the burden shifted to the appellant to come forward with evidence to rebut this challenge. *In re Doyle*, 482 F.2d 1385, 179 USPQ 227 (CCPA 1973); *In re Brown*, 477 F.2d 946, 177 USPQ 691 (CCPA 1973); *In re Ghiron*, 58 CCPA 1207, 442 F.2d 985, 169

USPQ 723 (1971). However, the burden was initially upon the examiner to establish a reasonable basis for questioning the adequacy of the disclosure. *In re Strahilevitz*, 668 F.2d 1229, 212 USPQ 561 (CCPA 1982), *In re Angstadt*, 537 F.2d 498, 190 USPQ 214 (CCPA 1976); *In re Armbruster*, 512 F.2d 676, 185 USPQ 152 (CCPA 1975).

The Examiner's attention is respectfully directed to page, 5, lines 4-15, of the specification. This passage states that a particularly large stress in a mobile telephone device is induced by evaluating data in a transmission block if all of the transmission blocks transmitted contain an address signal ADR, which addresses the mobile-telephone device under test. As further described in that paragraph, one way to limit the stress is to specify the number of transmission blocks that address the mobile-telephone device, i.e., stress is reduced if the number of transmission blocks addressing the mobile-telephone device is reduced. This variable specification of the number of transmission blocks with the address signal ADR, addressing the mobile-telephone device under test, enables the stress of the mobile-telephone device under test to be "influenced in a targeted manner," i.e., the tester can "influence" the stress by changing the number of transmission blocks addressing the mobile-telephone device under test.

Accordingly, since this portion of the specification clearly enables any one of ordinary skill in the art to make and use the claimed subject matter (without undue experimentation) by targeting the amount of stress on the mobile-telephone device under test through altering the number of transmission blocks, the Examiner has failed to establish a reasonable basis for questioning the adequacy of the disclosure. Therefore, the Examiner is respectfully requested to withdraw the rejection of claims 1-14 under 35 U.S.C. § 112, first paragraph.

Regarding the rejection under the second paragraph of 35 U.S.C. § 112, the Final Office Action states that claims 1-14 are indefinite because "it is unclear whether the limitations following the phrases "in a manner such" and "targeted manner" are part of the claimed

invention. Furthermore, it is not clear how stressing the mobile-telephone under test is influenced in a targeted manner the number of transmission blocks of a multi-block” (Final Office Action-page 4).

The Examiner is again respectfully directed to page, 5, lines 4-15, of the specification. It is clear from this portion of the specification that the following the phrases, “in a manner such” and “targeted manner,” are “part of the claimed invention.” The claims define the invention and all words within the claim must be considered when analyzing the metes and bounds of the claims. More specifically, it is very clear, for the reasons above, as to how stressing of the mobile-telephone device under test is influenced in a targeted manner. That is, the stress is determined by specifying the number of transmission blocks with the address signal ADR. Therefore, the stressing of the device under test is reduced (or “influenced in a targeted manner”) by reducing the number of transmission blocks addressing the device under test and the stressing of the device under test is increased (or “influenced in a targeted manner”) by increasing the number of transmission blocks addressing the device under test.

Accordingly, the claims are not indefinite and the Examiner is respectfully requested to withdraw the rejection of claims 1-14 under 35 U.S.C. § 112, second paragraph.

With regard to the rejection of claims 1-14 under 35 U.S.C. § 102(e), Applicants respectfully traverse this rejection because *Harris et al.* does not anticipate the instant claimed subject matter. *Harris et al.* does teach the testing of a device and the determination of an error rate (e.g., see claim 12 of *Harris et al.*). However, *Harris et al.* lacks any teaching of determining an error rate “based on the number of incorrectly-evaluated transmission blocks,” wherein the number of transmission blocks of multiblocks, which address the device under test, is a number of transmission blocks of multiblocks “**specified in a manner such that the stress to which the mobile-telephone under test is subjected is influenced in a targeted**

manner between one transmission block per multiblock and all of the transmission blocks of the multiblock, wherein a multiblock includes a fixed number of transmission blocks,” as in claim 1. *Harris et al.* also lacks a teaching of similar features in claim 9.

A rejection for anticipation under section 102 requires that the four corners of a single prior art document describe every element of the claimed invention, either expressly or inherently, such that a person of ordinary skill in the art could practice the invention without undue experimentation. See *Atlas Powder Co. v. Irecos Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999); *In re Paulsen*, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

The Final Office Action, at pages 4-6, discusses determining an error rate in a data transmission in accordance with the teachings of *Harris et al.* It discusses transmitting an excitation signal to the unit under test equal to the test signal 315 added to the interference signal 335 and it discusses comparing received information on a received result signal 360 to the original information on the test signal 315 to determine if a test is successful. The Final Office Action also discusses subdividing a test band to locate the frequency or frequencies causing the error. Conspicuously, the Final Office Action lacks any indication of a teaching in *Harris et al.* of a number of transmission blocks **“specified in a manner such that the stress to which the mobile-telephone under test is subjected is influenced in a targeted manner between one transmission block per multiblock and all of the transmission blocks of the multiblock, wherein a multiblock includes a fixed number of transmission blocks.”** Nothing in *Harris et al.* corresponds to this feature of the claims.

Accordingly, the Examiner is respectfully requested to withdraw the rejection of claims 1-14 under 35 U.S.C. § 102(e).

New claims 15-31 are presented. These claims are allowable for the reasons presented above, and for the following additional reasons.

Independent claim 15 corresponds to independent claim 1 with the additional recitations that the transmission blocks are “addressed to the mobile-telephone under test” and that the transmission blocks “belong to successively sent multiblocks” (see page 16, line 5 of the specification for support). Claim 15 further clarifies the language of claim 1 in reciting that the error rate is determined based on the number of incorrectly-evaluated transmission blocks “in relation to the number of the transmission blocks transmitted and addressed as a whole to the mobile-telephone device under test” (see page 5, second paragraph, of the specification for support).

New claims 16-18 correspond to claims 2-4, adding the recitation that the transmission blocks are not only addressed but “transmitted and addressed.”

New independent claim 19 is an apparatus counterpart to independent claim 15, with new dependent claims 20 and 21 corresponding to claims 10 and 11, respectively.

The claimed invention, according to certain embodiments, provides a number of advantages. For example, the advantage of changing “the number of transmission blocks transmitted and addressed to the mobile-telephone device under test...for multiblocks of the same transmission channel disposed in time succession relative to one another” (e.g., claim 1) is that the error rate determined during the test procedure captures even errors resulting from the stress of a dynamic recognition of the transmission blocks addressed to the mobile-telephone device under test under all transmission blocks transmitted.

Additionally, the transmission blocks transmitted and addressed to the mobile-telephone device under test are arranged randomly within a multiblock. This arrangement prevents systematic errors. Further, it is possible to use predefined sequences of numbers of successively

transmitted transmission blocks without detecting these sequences by pattern recognition units of the mobile-telephone device under test. Therefore, a reproducible sequence of numbers of successively transmitted transmission blocks can be used for multiple mobile-telephones for achieving comparable results regarding the error rates for different mobile-telephones under test. Comparable error rates can be obtained without allowing a detection of a test situation by the mobile-telephone, thus thwarting possible attempts by a mobile-telephone manufacturer to “cheat.”

New independent claim 22 is similar to independent claim 15 with the additional feature that “for each of the transmission channels the number and arrangement of the transmission blocks transmitted and addressed to the mobile-telephone under test are selected to be the same.” (See page 13, line 33 and page 14, lines 1-2 of the specification for support).

New independent claim 25 is the apparatus counterpart of claim 22 and a narrower version of claim 19.

New dependent claims 23, 24, and 26 correspond to claims 16, 18, and 21.

In addition to the advantages noted above, the additional features of claims 22 and 25 provide the advantage that the time needed for measuring the error rate can be reduced. For example, in 4 channels, if the same sequence of numbers and arrangements is selected, the measuring time can be reduced by a factor of 4 because, during an equivalent time, four times the amount of statistically evaluable data is measured. This is especially advantageous for the measurement of the error rate in dependence on the transmission blocks addressed to the mobile-telephone under test of a multiblock.

Claims 27-31 are similar to claims 22-26 but with an additional feature “that the increase in the error rate is evaluated in dependence on the number of the transmission blocks of a multiblock transmitted and addressed to the mobile-telephone device under test.” This feature

offers the advantage that the error rate of a mobile-telephone under test can be analyzed in dependence on the stress, i.e., the number of transmission blocks per multiblock transmitted and addressed to the mobile-telephone under test. The test procedure averages error rates measured under different stress conditions, leading to an allowable averaged error rate, even if the error rates measured during times when many or all of the transmission blocks are addressed to the mobile-telephone under test exceed an allowed limit of the error rate.

Therefore, the present application, as amended, overcomes the rejections of record and is in condition for allowance. Favorable consideration is respectfully requested. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at (703) 519-9952 so that such issues may be resolved as expeditiously as possible.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 504213 and please credit any excess fees to such deposit account.

Respectfully Submitted,

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